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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/612,515

07/02/2003

Kevin T. Stone

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EXAMINER

TYSON, MELANIE RUANO

ART UNIT

PAPER NUMBER

3773

MAIL DATE

DELIVERY MODE

05/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/612,515	Applicant(s) STONE ET AL.	
	Examiner Melanie Tyson	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 19, 20, 22-24, 39, 40, 42-45, 47-49, 51, 53, 55, 56, 58-61, 64 and 65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 19, 20, 22-24, 39, 40, 42-45, 47-49, 51, 53, 55, 56, 58-61, 64 and 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 March 2009 has been entered. Claims 10-18, 21, 25-38, 41, 46, 50, 52, 54, 57, 62, and 63 are canceled. New claim 65 has been added.

Response to Arguments

Applicant's arguments with respect to claims 1-9, 19, 20, 22-24, 39, 40, 42-45, 47-49, 51, 53, 55, 56, 58-61, 64, and 65 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9, 39, 40, 42, 47, 48, 51, 55, 60 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by **Simon et al. (U.S. Patent No. 6,264,677 B1)**. Simon discloses a suture anchor (see entire document) comprising a single unit formed of bioabsorbable polymers (for example, see column 3, lines 37-41) having a bone

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[anatomical] engaging section (16) with a bone [anatomical] engaging structure (threads) defining a maximum diameter (for example, see Figure 2), a non-threaded suture engaging section (18) extending from the bone [anatomical] engaging section and wherein an outermost annular surface defines a diameter less than the maximum diameter (for example, see Figure 2) such that it is able to be substantially disposed below an exterior surface of a boney structure after implantation, a first and second enclosed eyelet (opposing end portions of 20) formed as a completely surrounded bore in a proximal face of the suture engaging section (the sides are considered faces, wherein the portions containing the eyelets are the proximal portions of each face thus are considered a proximal face) to allow a selected portion of a suture to pass through the suture engaging section, a suture passage (20) interconnecting the first and second eyelets operable to allow a suture to enter and exit the suture engaging section from a single section (the suture engaging section) such that the selected portion of the suture remains substantially within the maximum diameter, and an access (cupped portions 34) to a first portion of the suture passage (at the eyelets) to allow access to the suture passage. The eyelets are capable of being substantially exposed after implantation if the suture engaging section were not entirely implanted below a surface and the suture is able to extend from the suture engaging section generally parallel and along an axis of the anatomical engaging section if pulled proximally and straightened. With further respect to claim 39, the suture engaging section is considered to be spaced a distance axially from the bone [anatomical] engaging section in that it lacks threads.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Simon et al.** It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the anchor with third and fourth eyelets and a second passage connecting the third and fourth eyelets, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

Claims 8, 19, 20, 22-24, 43-45, 49, 53, 56, 58, 59, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Simon et al.** in view of **Stone et al. (U.S. Patent No. 6,139,565)**. Simon discloses the claimed invention (see similar limitations above for independent claim 19 and claims depending therefrom) except for eyelets formed in a single terminal end wall that is substantially transverse to the bone engaging axis as claimed and a suture passage that allows a suture to be passed

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exterior of the suture engaging section at a point other than the eyelets. Stone discloses a suture anchor (see entire document). Stone teaches eyelets (19) formed on a proximal face of the suture engaging portion that comprises a surface transverse to the bone engaging axis configured to extend away from the bone engaging section (for example, see Figure 12A and 12B). Stone further teaches a suture passage forming a 90 degree angle for the suture and allows a suture to be passed to an exterior at a point other than the first and second eyelets configured to allow access to the suture passage through the sidewall (for example, see Figure 12B; portion 18 extends through from one sidewall surface to and through an opposite sidewall surface). It is well within the general knowledge of one having ordinary skill in the art to apply a known technique to a known device ready for improvement to yield predictable results. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form Simon's anchor as taught by Stone. Doing so would enable the user to access the suture at a position other than the eyelets and also enable the user to have access to the suture after implantation, thus enabling the user to work with the suture after implantation without having to remove the bone anchor and further preventing suture chafing once the anchor has been implanted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
April 27, 2009

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773